

Application No.: 09/904124

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Remarks

Claims 1-18 remain pending in the application.

Claims 1-18 stand rejected under 35 USC §103(a) as being unpatentable over Münzenberger et al. (U.S. No. 6,161,393) in view of Rodriguez et al. (U.S. No. 5,588,267). In addition to the reasons set forth in Applicant's previous responses, Application believes claims 1-18 are patentably distinguishable from the cited prior art for the reasons set forth below.

Independent claim 1 is directed to a firestop device including a housing and firestop material arranged in the housing, wherein the housing includes at least one frangible connection defining a removable band. Similarly, independent claim 18 is directed to a firestop device comprising a housing including a plurality of longitudinally arranged frangibly connected circumferential bands. The frangible connections allow unnecessary bands that extend beyond the partition after the concrete has been poured to be readily removed by a user. In this manner, the height of the device can be modified to correspond to the thickness (or depth) of the partition. The teachings of the cited prior art in no way render the invention of claims 1 and 18 unpatentable.

As noted by the Examiner, Münzenberger et al. fails to disclose a housing including at least one frangible connection defining a removable band. The Examiner asserts that Rodriguez et al. teach that it is known in the art to provide at least one frangible connection defining a removable band. Applicant disagrees.

First, the Rodriguez et al. reference is non-analogous art. Second, even if Rodriguez et al. is analogous art, there is no motivation to combine the references. And third, even if there were sufficient motivation to combine the references, there is not a reasonable expectation of success because the suggested combination would be inoperable.

As set forth in Applicant's response filed 6/10/03, Applicant submits that Rodriguez et al. is non-analogous art. Roof flashings are used to seal around pipes extending through roofs or other exterior walls of houses and other buildings. (See Rodriguez et al., col. 2, lines 12-14). The present invention, in contrast, relates to firestop devices for preventing the spread of fire and smoke from one compartment of a building to another. (See present application at page 1, lines 12-30). Because Rodriguez et al. is from the technological field of roof flashing and the present

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invention is from the technological field of firestopping, Rodriguez et al. is not within the same field of endeavor as the present invention, and is therefore non-analogous art. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. In re Oetiker, 24 USPQ2D 1443, 1446 (Fed. Cir. 1992).

In addition, the Rodriguez et al. reference is not reasonably pertinent to the particular problem involved with the present invention because the present invention is concerned with the problem of firestopping and Rodriguez et al. are concerned with roof flashing. Furthermore, the present invention is concerned with the particular problem of adjusting the height of the device depending on the thickness of the partition into which the device is installed, and Rodriguez et al. are concerned with the problem of accommodating pipes having different thicknesses. This problem is completely unrelated to the present invention.

To address the particular problem of adjusting the height of the device, the housing of present invention is provided with frangible connections defining removable bands to allow the height of the housing to be shortened, thereby to reduce the height of the housing depending on the thickness of the partition into which the device is installed. (See present application at page 3, lines 19-22) In contrast, to address the problem of accommodating pipes having different thicknesses, the Rodriguez et al. roof flashing is provided with an frusto-conical collar having smaller diameter upper and larger diameter lower seals and an annular groove 20 to permit a larger diameter set of edge seals to be used for sealing against larger size pipe. (See Rodriguez et al. Abstract and col. 4, lines 6-13). The two sets of seals 8,9 are not provided to allow the height of the roof flashing to be shortened such that the flashing can be used in partitions having a variety of thicknesses. Rather, they are provided to allow the device to be used with different diameter pipes. Accordingly, because the Rodriguez et al. reference is from a different technical field (namely, roof flashing), and because it addresses a different problem than the present invention (namely, accommodating pipe with different diameters), the information from Rodriguez et al. is so far removed from the field to which the present invention pertains that the information is not prior art.

Section §706.02(j) of the MPEP provides that in order to establish a *prima facie* case of obviousness under 35 U.S.C §103, there must be (1) some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings, and (2) a reasonable expectation of success.

Regarding the suggestion to combine the reference teachings, the Examiner asserts that the motivation is found in the knowledge generally available to one of ordinary skill in the art. Applicant respectfully disagrees and requests that the Examiner cite a reference in support of this position. Rather, Applicant submits that because Münzenberger et al. indicates that the lengthening pipe 7 can be "easily cut-off" (col. 4, line 14, emphasis added), there would be no reason to provide the lengthening pipe with frangible connections to modify its length.

Regarding the reasonable expectation of success, Applicant submits that even if the references were combined in the manner suggested by the Examiner, there is not a reasonable expectation of success. The Rodriguez et al. device includes a "frusto-conical shape collar member having a plurality of seals for sealingly engaging different diameter pipes." (Rodriguez et al. col. 1, lines 35-37) "To permit the lower larger diameter set of edge seals 12,13 to be used for sealing against larger size pipe, for example, 3 inch pipe, the upper set of seals 10,11 must first be removed from the collar member." (Rodriguez et al. col. 4, lines 6-11) Thus, Rodriguez et al. teach the use of a frusto-conical collar having two sets of seals to allow the device to be used with different diameter pipes. And it is because of its conical shape that the length of the collar member 4 can be used to accommodate pipes having different diameters. The collar member, however, must be adjusted precisely, otherwise the pipe will either be too large and will not fit, or the pipe will be too small and will not form a proper seal.

The Münzenberger et al. device is provided with a cylindrical lengthening pipe 7 having a constant diameter. (Münzenberger et al. Figs. 1 and 2) If, on the other hand, the Münzenberger et al. device were modified in accordance with Rodriguez et al. to have a tapered lengthening pipe to accommodate different diameter pipes, when the lengthening pipe is cut-off to the desired length to match the thickness of the concrete floor, it would not match the diameter of the pipe. That is, the opening in the device would either be too small and the pipe would not fit through the opening, or the opening would be too large resulting in an excessively large or uneven gap between the device and the pipe. Thus, if the teachings of Rodriguez et al. and Münzenberger et

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al. were combined, the references would produce an inoperative combination. The requisite reasonable expectation of success is, therefore, lacking.

Applicant also disagrees that Mützenberger et al. disclose a removable band including a pull tab providing grasping means for allowing a user to remove the bands from the housing at the frangible connection as defined in claim 2. The Examiner contends that reference numeral 8 of Mützenberger et al. points to a manually engageable pull tab. This is erroneous. Reference numeral 8 identifies "radial circumferential ribs" which serve as loss preventing means for the fixture, particularly during vertical mounting. (Mützenberger et al., col. 4, lines 19-21). These ribs, however, do not and are not intended to provide grasping means to allow a user to remove a band from the housing along the frangible connection as defined in claim 2.

Applicant also disagrees that Mützenberger et al. disclose a device wherein the sides wall and the shoulder portion include inner surfaces having ribs as defined in claim 5. The Examiner contends that reference numeral 15 of Mützenberger et al. identifies a rib. This is erroneous. Reference number 15 identifies a locking ring that retains the intumescent ring 11 in a predetermined position. (Mützenberger et al., col 4, lines 31-33) The locking ring, however, does not constitute "ribs" and it is not provided on the inner surface of the side wall and shoulder portion as defined in claim 5. Thus, at least claims 2 and 5 are believed to contain separately patentable features.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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Date

By: David B. Patchett
David B. Patchett, Reg. No.: 39,326
Telephone No.: (651) 736-4713

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833